

### **REMARKS**

In the Office Action dated August 22, 2006, the Examiner objected to claims 28-29 and 37 because of asserted minor informalities; rejected claims 1-30, 32-46, and 48 under 35 U.S.C. § 112, second paragraph, rejected claims 31-32 under 35 U.S.C. §102(b) as being anticipated by Kenet et al. (US Patent 5,291,889); rejected claim 47 under 35 U.S.C. § 102(b) as being anticipated by Linford et al. (US Patent No. 6,081,611); rejected claims 1-4, 6-24, 27-29, and 33-48 under 35 U.S.C. § 103(a) as being unpatentable over Kenet et al. in view of Proactiv; and rejected claims 5 and 25-30 under 35 U.S.C. § 103(a) as being unpatentable over Kenet et al. in view of Proactiv and further in view of Linford et al.

By this Amendment, Applicants have amended claims 1, 3, 8, 9, 12-15, 20, 32, 35-37, 39-42, 44, and 47-48. Claims 1-48 remain pending.

#### **I. Objection of Claims 28-29 and 37**

Applicants have amended claim 3, without narrowing its scope, to recite "representative image." Claims 28-29 now reflect proper antecedent basis based on the amendment to claim 3. Applicants have also amended claims 37, without narrowing its scope, to recite "comprises means for receiving." Applicants greatly appreciate the Examiner's helpful suggestions and respectfully request that the objection to claims 28-29 and 37 be withdrawn.

#### **II. Rejection of Claims 1-30, 32-46, and 48 under 35 U.S.C. § 112**

The Examiner asserts on page 3 of the Office Action that "throughout the application" the Applicants refer to "database information and information in the database." The Examiner suggests for the Applicants to "rephrase the terminology

being used and to be consistent in referring back to the terminology.” Applicants respectfully direct the Examiner’s attention to the specification, for example, at pages 11-12, which includes disclosure of “maintaining, in a database, information on how use of at least one beauty product affects evolution of the external body condition.” The specification as well as the claims, as amended, refer to “information in a database.” Therefore, for at least these reasons, Applicants respectfully request the Examiner to withdraw the rejection of claims 1, 32, and 48, as well as dependent claims 2-20, 22-30, and 33-46.

With regard to claims 21 and 45, the Examiner states that he “does not understand why a portion of the information in the database based on the comparing is selected and how only using a portion of the information based on the comparing is used for the prognosis. . . [and that he] would appreciate if the Applicants can clarify the wording or present an explanation of what is going on.” (Office Action, page 3). Applicants respectfully draw the Examiner’s attention to the specification, for example, at page 16, paragraph 44 to page 17 paragraph 48, which includes disclosure relating to “comparing the representation with information in the database and selecting a portion of the information in the database based on the comparing,” as recited in claims 21 and 45. Based on at least this description, one of ordinary skill in the art, would have understood, at the time the application was filed, how to make and use the claimed subject matter. For at least these reasons, Applicants respectfully request the Examiner to withdraw the rejection of claims 21 and 45.

Applicants have amended claim 48, without narrowing its scope, to recite, “[a] computer-readable medium which stores a set of instructions which when executed

performs.” Claim 48 fully complies with section 112, second paragraph. Therefore, Applicants respectfully request the Examiner to withdraw the rejection of claim 48.

**III. Rejection of Claims 31-32 under 35 U.S.C. § 102(b)**

In order for Kenet et al. to anticipate Applicants’ claims under 35 U.S.C. § 102(b), each and every element of the claim at issue must be found, either expressly or under principles of inherency, in the reference. Further, “[t]he identical invention must be shown in as complete detail as is contained in the . . . claim.” See M.P.E.P. § 2131 (quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

Kenet et al. fails to anticipate claims 31-32 because Kenet et al. does not disclose, expressly or otherwise, each and every feature recited in claims 31-32. For example, Kenet et al. does not disclose “information of how use of at least one beauty product affects evolution of [an] external body condition,” as recited in claims 31-32.

In the Office Action, the Examiner does not even identify any portion of Kenet et al. allegedly corresponding to the above-recited claim limitations except by stating that “a database for storing information [is] inherently included in a computer system.” (Office Action, page 4). In fact, on page 5 of the Office Action the Examiner admits that “Kenet fails to explicitly show ‘. . . maintaining in a database information of how using a beauty product affects the evolution of an external body condition’.” Nothing provides any support for the Examiner’s inherency allegation relating to the rejection of claims 31-32. If the Examiner maintains this rejection, Applicants respectfully request the Examiner to point out what portions of Kenet et al. alleged teach or suggest these claims limitations, in addition to explaining the basis for alleging inherency.

For at least the reasons explained above, Kenet et al. fails to teach each and every element of claims 31-32. Applicants, therefore, respectfully requests the Examiner to withdraw the 35 U.S.C. § 102(b) rejection of claims 31-32.

**IV. Rejection of Claim 47 under 35 U.S.C. § 102(b)**

Linford et al. fails to anticipate claim 47 because Linford et al. does not disclose, expressly or otherwise, each and every feature in claim 47. For example, Linford et al. does not disclose “a database containing information on how use of at least one beauty product affects evolution of [an] external body condition,” as recited in claim 47.

In the Office Action, the Examiner cites column 5, lines 30-36 Linford et al. for the asserted disclosure of subject matter including a database. Applicants respectfully disagree with the Examiner’s apparent attempt to equate this portion of Linford et al. with the claim recitations. The portion of Linford et al. cited by the Examiner describes an imaging system that includes an imaging program that runs on a processing unit controlled by an operating system. (Col. 5: 30-31). A memory is connected to the processing unit and generally comprises, for example, random access memory, read only memory, and magnetic storage media such as a hard drive, floppy disk, or magnetic tape. Linford et al. does not provide any disclosure or teaching of “a database containing information on how use of at least one beauty product affects evolution of [an] external body condition,” as recited in claim 47. Therefore, Linford et al. fails to teach each and every element of claim 47. Accordingly, Applicants respectfully request the Examiner to withdraw the 35 U.S.C. § 102(b) rejection of claim 47.

**V. Rejections of Claims 1-30 and 33-48 under 35 U.S.C. § 103(a)**

In order to establish a *prima facie* case of obviousness, three basic criteria must be met. First, the prior art references must teach or suggest all the claim elements. Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine reference teachings. Third, there must be a reasonable expectation of success. See M.P.E.P. § 2143.

Here, the cited references cannot support a rejection under 35 U.S.C. § 103(a) because, among other things, Kenet et al., Proactiv, and Linford et al., taken alone or in any proper combination, do not disclose, teach, or suggest each and every feature recited in Applicants' claims 1 and 48. Claims 1 and 48 recite, "generating at least one prognosis reflecting predicted changes in the external body condition after use of said at least one beauty product, wherein the generating is based on both the representation and information contained in the database."

The Examiner cites column 1, lines 46-47 and column 3, lines 25-29 of Kenet et al. for the asserted disclosure of "generating...." Applicants respectfully disagree with this interpretation of Kenet et al.

Kenet et al. is directed to a method of facilitating the positioning of a live image with respect to a reference image in which the live and the reference images are combined to produce a composite image that is displayed. (Abstract). The portions of Kenet et al. cited by the Examiner describe using "before and after photographs of regions of skin . . . to document the benefits of a treatment." (Col. 1: 45-47). One aspect of the system uses a combiner that multiplies each of the images by a mask

function and performs a combining function, “taking two images as its input and outputting a single image.” (Col. 3: 25-29). Kenet et al. does not disclose at least one “prognosis,” much less “generating at least one prognosis reflecting predicted changes in the external body condition after use of said at least one beauty product, wherein the generating is based on both the representation and information contained in the database,” as recited in claims 1 and 48.

The Kenet et al. system merely combines two images into one using masking functions. The system allows before and after photographs of skin to show the benefits of a treatment. (Col. 1: 45-47). However, this is not a teaching or suggestion of “at least one prognosis reflecting predicted changes,” as recited in claims 1 and 48. Therefore, Kenet et al. fails to teach or suggest “generating at least one prognosis reflecting predicted changes in the external body condition after use of said at least one beauty product, wherein the generating is based on both the representation and information contained in the database,” as recited in claims 1 and 48.

Proactiv and Linford et al. do not overcome the above-noted shortcomings of Kenet et al. The Examiner cites Proactiv for the asserted disclosure of “how use of a beauty product affects the evolution of an external body condition.” (Office Action, page 5). Linford et al. is cited for the asserted disclosure of “three-dimensional image[s].” (Office Action, page 9). However, Proactiv and Linford et al. do not disclose or suggest “generating at least one prognosis reflecting predicted changes in the external body condition after use of said at least one beauty product, wherein the generating is based on both the representation and information contained in the database,” as recited in claims 1 and 48. Nor does the Examiner assert otherwise in the Office Action.

Accordingly, Kenet et al., Proactiv, and Linford et al., taken along or in any proper combination, do not teach or suggest each and every feature recited in Applicants' independent claims 1 and 48, and, therefore, cannot support a rejection of these claims or dependent claims 2-30 under 35 U.S.C. § 103(a).

Moreover, claims 31-32 and 47, although of different scope than claims 1 and 48, recite at least some similar limitations as claims 1 and 48. Kenet et al. does not disclose each of the features of claim 31-32 and 47 for at least one reason similar to one of those discussed above for claims 1 and 48. For example, Kenet et al. does not disclose "a processor ... to generate at least one prognosis reflecting predicted changes in the external body condition after use of ... at least one beauty product," as recited in claims 31 and 47. Kenet et al. also does not disclose "means for generating at least one prognosis reflecting predicted changes in the external body condition after use of said at least one beauty product, wherein the generating is based on both the representation and information contained in the database," as recited in claim 32. Accordingly, Kenet et al., Proactiv, and Linford et al., taken along or in any proper combination, do not teach or suggest each and every feature recited in Applicants' independent claims 31-32, and 47 and, therefore, cannot support a rejection of any of these claims or dependent claims 33-46 under 35 U.S.C. § 103(a). Accordingly, reconsideration and withdrawal of the rejection is respectfully requested and deemed appropriate.

## **CONCLUSION**

Applicants respectfully request reconsideration of this application and the timely allowance of claims 1-48.

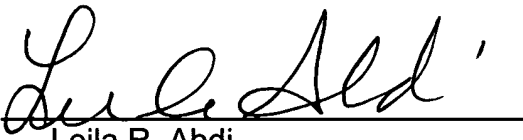
The Office Action contains a number of statements relating to characterizations of the claims, disclosure, and/or cited references. Regardless of whether any such statement is mentioned above, Applicants decline to subscribe to any characterization in the Office Action.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: October 18, 2006

By:   
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